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April 9, 2007

FACSIMILE COVER SHEET

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TO:	RE:
Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application No. 10/528,515 Filing Date: October 26, 2005
TELEPHONE:	**FACSIMILE:**
(571) 272-1335 Examiner: Jonathan M. Dunlap	(571) 273-8300

MESSAGE

The following document is submitted with this Cover Sheet:

Reply to Requirement for Restriction

Any necessary fees can be charged to Deposit Account No. 03-2405.

PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of	:	Confirmation No. 4336
Ian E. Kibblewhite, et al.	:	Group Art Unit 2855
Application No. 10/528,515	:	Examiner: Jonathan M. Dunlap
Filing Date: October 26, 2005	:	(571) 272-1335
For a Patent for	:	
THREAD FORMING FASTENERS FOR ULTRASONIC LOAD MEASUREMENT AND CONTROL	:	April 9, 2007

REPLY TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is being filed to reply to the Office Action issued in this matter on March 7, 2007, which requires restriction to one of four identified groupings of claims under 35 U.S.C. §121 and 35 U.S.C. §372. For reasons which follow, this restriction requirement is respectfully traversed.

The present U.S. patent application was filed under the provisions of 35 U.S.C. §371, as a national stage application deriving from International Application No. PCT/US2003/029302. As a consequence, the Office Action of March 7, 2007, correctly

applies a "unity of invention" standard to the claims of this patent application under PCT Rule 13 and 37 C.F.R. §1.499 (noting Section 1893.03(d) of the Manual of Patent Examining Procedure).

Under a unity of invention standard, PCT Rule 13.1 permits applicants to include "inventions so linked as to form a single general inventive concept" in a single application. Under PCT Rule 13.2, this would be proper "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features".

However, at Paragraph 5 of the Office Action of March 7, 2007, the position is taken that the identified groupings of claims "fail to meet the requirements of PCT Rule 13.2" for the stated reason that "they present an illegal combination of different categories of inventions" because "[a]ccording to Rule 13.2, only one invention in each category (product, process or apparatus) may be permitted" and the identified groupings of claims "present a product, a process of making the product and two uses of the product".

PCT Rule 13.2 states that:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

From this, it is apparent that PCT Rule 13.2 makes no reference to "categories of inventions", or to "product, process or apparatus" claims. Neither does PCT Rule 13.2 make reference to "combination[s] of different categories of inventions", or "illegal" combinations of such categories.

Accordingly, it is submitted that no valid basis has been provided for making a requirement for restriction, and that the requirement for restriction is, therefore, properly withdrawn.

It is recognized that 37 C.F.R. §1.499 indicates that if a national stage application is considered to lack unity of invention under 37 C.F.R. §1.475, an Office Action requiring restriction can properly be issued, and that 37 C.F.R. §1.475(b) does refer to "categories" of inventions. However, 37 C.F.R. §1.475(b) identifies combinations of categories of inventions that applicants are specifically entitled to claim in a single application. Nothing in 37 C.F.R. §1.475(b) operates to proscribe any combinations of categories of inventions as "illegal", nor is there any indication that combinations of categories of inventions other than the identified combinations cannot satisfy the unity of invention standards of PCT Rule 13.

To the contrary, 37 C.F.R. §1.475(c) specifically indicates that:

> If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b)..., unity of invention <u>might</u> not be present.... (emphasis added)

Clearly then, there is no proscription of any combinations of categories of inventions by 37 C.F.R. §1.475. Rather, there is a restatement of the applicable standards for determining when there is unity of invention, noting 37 C.F.R. §1.475(a), which follows the standards set forth in PCT Rule 13.

Accordingly, it is submitted that there is no valid basis for objecting to unity of invention merely because the claims of an application are directed to different combinations of categories of inventions, and once again, that the requirement for restriction is properly withdrawn.

From the foregoing, and in view of PCT Rule 13, 37 C.F.R. §1.499 and 37 C.F.R. §1.475, applicants have a right to include "inventions so linked as to form a single general inventive concept" in a single application, and this would be proper "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features".

In the present application, applicants' independent claims 1, 10, 19 and 29, which head the four Groups of claims identified in the Office Action of March 7, 2007, are directed to an ultrasonic transducer which is coupled with a thread-forming fastener, for purposes of making ultrasonic load measurements in the fastener. Accordingly, it is submitted that at least one common special technical feature has been shown to be present in the several Groups of claims identified in the Office Action of March 7, 2007, and that such claims, therefore, satisfy a

unity of invention standard.

In view of the foregoing, a reconsideration and withdrawal of the restriction requirement formulated in the Office Action of March 7, 2007, is respectfully requested, and an examination of all claims is earnestly solicited.

It is noted that to be complete, applicants' reply to the Office Action of March 7, 2007, "must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143)". In reply, applicants provisionally elect the subject matter identified in the Office Action as Group I, including claims 1 to 9, for purposes of examination in the event that the restriction requirement is maintained.

It is further noted that claims 10 to 18 are said to be "drawn to a method of making a load indicating thread-forming fastener", at Paragraph 3 of the Office Action of March 7, 2007. As a consequence, and even in the event that the requirement for restriction is maintained, it is submitted that claims 10 to 18 would also be properly examined in this application pursuant to the provisions of 37 C.F.R. §475(b)(1).

Corresponding action is earnestly solicited.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300) on: April 9, 2007.

Date: 4/9/07

Gary M. Cohen, Esq.